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EXAMINER

COLON, CATHERINE M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/746,611

**Applicant(s)**

PERRY ET AL.

**Examiner**

C. Michelle Colon

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on July 19, 2004. Claims 1, 2, 4, 18, 22, 25, 32, 33 and 36 have been amended. Claims 1-38 are now pending in this application.

#### ***Response to Amendment***

2. Applicant's amendments to the claims are sufficient to overcome the 35 U.S.C 112, second paragraph, rejection and the claim objections set forth in the previous Office Action. Therefore, the 35 U.S.C 112, second paragraph, rejection and the claim objections set forth in the previous Office Action are withdrawn.

#### ***Response to Arguments***

3. Applicant's arguments have been fully considered but are found unpersuasive. In the Remarks, Applicant argues that Wright does not disclose or suggest submission of two structures for the same proposal and then evaluating and ranking the two structures.

In response to the argument, Examiner respectfully disagrees. In col. 2, lines 39-48, Wright discloses the formation of partnerships and submission of proposals for the completion of a project. In col. 3, lines 51-55, Wright discloses resource providers forming partnerships to perform work on projects. In col. 4, lines 63-67, Wright discloses project owners requesting proposals for projects. In col. 6, lines 3-6 and 34-37, Wright discloses that partnerships and alliances are formed among resource

providers for completing work for a project. Additionally, in col. 9, lines 46-53, Wright discloses resource providers *submitting proposals/bids for projects that include forming partnerships and alliances with other resource providers*. Wright also discloses that proposals are evaluated by the project owners in col. 4, lines 56-59. Lastly, in col. 9, lines 19-25 and col. 11, lines 25-48, Wright discloses selecting resource providers according to criteria such as capabilities, preferences and *ratings* and further, that the resource providers and their related data can automatically be filtered according to the criteria submitted through templates by the project owners. Thus, Examiner respectfully submits that Wright does disclose the submissions of partnerships and alliances among resource providers in a proposal/bid to do work for a project. Furthermore, Examiner respectfully submits that Wright discloses ranking the proposals using criteria such as capabilities, preferences and ratings of the resource providers, who can also be automatically filtered based on the criteria provided by the project owners. Examiner also points out that claim 1 does not in any way recite *how the ranking occurs* nor *how the evaluated information is used to rank the structures*. Accordingly, prior art that teaches ranking of proposal-related information in any broadest reasonable interpretation of the term, ranking, would anticipate the claim. Examiner also notes that on page 12 of the Remarks, Applicant asserts that the various *possible financial results* of the structures recited in claim 1 are *inherently* part of the claim. Examiner respectfully disagrees and further asserts that the fact that a structure can have a financial result that is a possibility and that is not definite shows that the financial result is not inherent to the structure. Therefore, the various examples of the combinations of

financial results for the different structures discussed on page 12 of the Remarks cannot be read into the claims. Also, the definitions referenced in the Specification on page 12 of the Remarks cannot be read into the claims. If such possible financial results are deemed critical to the novelty of the invention, it is suggested the features be added to the claims.

Therefore, Applicant's arguments have been fully considered, but are found unpersuasive. Claims 1-38 are rejected below.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-7, 10-14, 16-21, 26-33, 35, 36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright et al. (U.S. 6,581,040).

As per claim 1, Wright et al. discloses a method of evaluating a business proposal, comprising the steps of:

gathering information relevant to the proposal, wherein the information comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement

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of the proposal, and an innovation value of the proposal, and wherein the proposal includes at least two structures selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture (col. 2, lines 39-58; col. 3, lines 51-55; col. 4, lines 39-59; col. 5, lines 45-col. 6, line 37; col. 7, lines 29-60; col. 8, lines 7-30; col. 8, line 62-col. 9, line 18; The system gathers information on proposals submitted by resource providers for projects.);

evaluating the gathered information by computer (col. 4, lines 54-59; Project owners review bids/proposals for projects before selecting a resource provider.); and

ranking the at least two structures according to the evaluation of the gathered information (col. 7, lines 23-27; col. 9, lines 19-25; The system has an internal sorting function for data submitted.).

As per claim 2, Wright et al. discloses the method of claim 1, wherein information gathered further comprises at least one of business environmental information, revenue drivers, business risks, and legal liabilities (col. 10, lines 3-39).

As per claim 3, Wright et al. discloses the method of claim 1, wherein the information gathering step further comprises answering predetermined questions on at least one template stored in a computer and the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 6, lines 17-30; col. 7, line 61-col. 8, line 59; col. 11, lines 25-67; The system uses templates to facilitate communication between project owners and resource providers.).

As per claim 5, Wright et al. discloses the method of claim 1, further comprising evaluating risks of the proposal as high or normal (col. 9, lines 19-25).

As per claim 6, Wright et al. discloses the method of claim 1, further comprising choosing an input into the computer by a radio-button technique (col. 10, lines 3-55; The system provides a web interface for users to interact with the system.).

As per claim 7, Wright et al. discloses the method of claim 1, further comprising displaying the rankings with a graphical user interface (col. 10, line 56-col. 11, line 51; The system sorts data based on criteria and then displays the data for particular users.).

As per claim 10, Wright et al. discloses the method of claim 1, wherein the cost of the proposal is calculated as a revenue stream to a service provider (col. 9, lines 46-53).

As per claim 11, Wright et al. discloses the method of claim 10, further comprising the steps of calculating a benefit to the customer of providing said service to said customer (col. 8, lines 23-49; Resource providers are able to convey their capabilities and service offerings by using templates that match the resource providers to projects.).

As per claim 12, Wright et al. discloses the method of claim 1, wherein the information is input to the computer through a graphical user interface by choosing selections from at least one of a drop-down screen, a scroll screen, a check box, and a list box (col. 10, lines 3-55; The system provides a web interface for users to interact with the system.).

As per claim 13, Wright et al. discloses the method of claim 12, wherein the graphical user interface uses a technique selected from the group consisting of a drop-down screen, a scroll screen, a check box, and a list box (col. 10, lines 3-55; The system provides a web interface for users to interact with the system.).

As per claim 14, Wright et al. discloses the method of claim 1, wherein the proposal comprises an offer of a service from a provider, and further comprising the step of calculating a way to pay for the proposal (col. 9, lines 46-67).

As per claim 16, Wright et al. discloses the method of claim 1, wherein the information is provided through a graphical user interface, and the input is in a form of brief numerical or pseudo-numerical outputs (col. 9, lines 46-67; The resource providers formulate price quotes for one or more projects. Price quotes are a numerical form.).

As per claim 17, Wright et al. discloses the method of claim 1, wherein an output is provided through a graphical user interface, and the output is in a form of brief numerical or pseudo-numerical outputs (col. 9, lines 46-67; The resource providers formulate price quotes for one or more projects. Price quotes are a numerical form.).

As per claim 18, Wright et al. discloses a method of evaluating a business proposal, comprising:

searching at least one database for information concerning a business partner, the proposal and a business environment, wherein the information includes cost drivers, revenue drivers, markets served, risks of the proposal, customers served, and a competitive advantage (col. 4, lines 32-59; col. 5, lines 45-67; col. 7, lines 29-67; col. 8,



lines 7-30; col. 8, line 62-col. 9, line 18; The system gathers information on proposals submitted by resource providers for projects.);

providing financial data concerning the proposal to a computer, wherein the financial data includes revenue elements of the proposal, a cost of the proposal, and an innovation value of the proposal (col. 9, lines 46-67; col. 16, lines 7-9);

proposing at least two structures for the business proposal, using said financial data and information from the database, wherein the structures are selected from the group comprising of an alliance, an acquisition, an equity venture, a partnership, and a venture (col. 2, lines 39-58; col. 3, lines 51-55; col. 6, lines 3-37; col. 8, line 62-col. 9, line 18; col. 9, lines 46-53); and

calculating an advantage of the structures based on the searched-for information and the provided financial data (col. 7, lines 23-27; col. 9, lines 19-25; The system has an internal sorting function for data submitted and rates resource providers.).

As per claim 19, Wright et al. discloses the method of claim 18, wherein the database comprises a client relationship repository of information (col. 7, lines 20-28 and 54-65).

As per claim 20, Wright et al. discloses the method of claim 18, further comprising evaluating risks of the proposal as high or as normal and receiving an input of a risk evaluation through a graphical user interface (col. 9, lines 19-25; The system allows users to evaluate the suitability of resource providers with certain projects. The resource providers are evaluated on capabilities, ratings and preferences.).

As per claim 21, Wright et al. discloses the method of claim 18, wherein the step of providing financial data comprises retrieving financial data from at least one database (col. 9, lines 9-38; Resource providers provide information on bids and proposals to the database.).

As per claim 26, Wright et al. discloses the method of claim 18, wherein the advantage is calculated as at least one revenue stream and includes an example of how to pay for the service (col. 7, lines 23-27; col. 9, lines 19-25 and lines 46-67).

As per claim 27, Wright et al. discloses the method of claim 18, further comprising the step of ranking each structure (col. 7, lines 23-27; col. 9, lines 19-25; The system has an internal sorting function for data submitted.).

As per claim 28, Wright et al. discloses the method of claim 18, wherein the advantage is recalculated by a step of entering updated data into the computer (col. 7, lines 54-60).

As per claim 29, Wright et al. discloses the method of claim 18, wherein the step of searching comprises a search of at least one Internet site, and further comprising the steps of updating the search periodically, and updating the computer calculation of an advantage periodically (col. 10, lines 40-49).

As per claim 30, Wright et al. discloses the method of claim 18, wherein the information is provided through a graphical user interface (col. 10, lines 40-67).

As per claim 31, Wright et al. discloses the method of claim 18, further comprising a step of providing an output through a graphical user interface (col. 10, lines 40-67; Figure 5).

As per claim 32, Wright et al. discloses a computer system for evaluating a proposal, comprising:

a computer processor (col. 10, lines 3-25);

at least one memory operably connected to said computer, said memory containing data relevant to the proposal, wherein the data comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal (col. 2, lines 39-58; col. 3, lines 51-55; col. 4, lines 39-59; col. 5, lines 45-col. 6, line 37; col. 7, lines 29-60; col. 8, lines 7-30; col. 8, line 62-col. 9, line 18; The system gathers information on proposals submitted by resource providers for projects.); and

a computer program residing in said computer or in said memory, wherein the proposal includes a plurality of structures selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture, and computer program is configured for calculating and generating an output for evaluating the plurality of structures based on said data relevant to the proposal (col. 4, lines 54-59; col. 7, lines 23-27; col. 9, lines 19-25; col. 9, lines 46-53; Project owners review bids/proposals for projects before selecting a resource provider. The system utilizes an internal sorting function to evaluate the resource providers.).

As per claim 33, Wright et al. discloses the computer system of claim 32, wherein the computer program is configured for generating a graphical user interface for at least one of inputting or outputting information (col. 10, lines 40-67; Figure 5).

As per claim 35, Wright et al. discloses the computer system of claim 32, wherein the computer program further comprises at least one template of predetermined questions, and the computer program uses the answers to said questions to evaluate the proposal (col. 6, lines 17-30; col. 7, line 61-col. 8, line 59; col. 11, lines 25-67; The system uses templates to facilitate communication between project owners and resource providers.).

As per claim 36, Wright et al. discloses the computer system of claim 32, wherein the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer program is configured to evaluate the proposal based on the answers to said questions (col. 6, lines 17-30; col. 7, line 61-col. 8, line 59; col. 11, lines 25-67; The system uses templates to facilitate communication between project owners and resource providers.).

As per claim 38, Wright et al. discloses the computer system of claim 32, wherein the computer program uses a technique of control-action-response in seeking and inputting information from a user of the computer system (col. 9, line 39-col. 10, line 49; col. 11, lines 11-48; The system uses extensive communication services that allow users to seek and share information.).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 8, 9, 15, 22-25, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (U.S. 6,581,040) as applied above.

As per claims 4 and 25, Wright et al. does not expressly disclose the method of claims 1 and 18, wherein the proposals are evaluated by calculating at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, and internal rate of return, and a net present value. However, Wright et al. does disclose evaluating the proposals based on a variety of criteria including cost (col. 9, line 46-col. 10, line 2). It is old and well known that cost is a necessary factor used in measuring other financial data such as revenue, return on investment and net present value since cost must be subtracted from the overall gain of money to calculate such financial data. It is also old and well known to use a determination of profits or gain of money to evaluate a business proposal as most businesses seek opportunities to gain profits/money. Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art for the system of Wright et al. to calculate at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, internal rate of return, or a net present value to evaluate proposals since Wright et al. already calculates cost, which is required to calculate the aforementioned financial data.

Furthermore, determining revenue stream, a return on average assets, a return on investment, a return on equity, internal rate of return, or a net present value helps a business to determine the potential financial rewards of the proposal, gaining some financial benefit being the purpose of accepting the proposal for most businesses.

As per claims 8 and 37, Wright et al. does not expressly disclose the method and computer system of claims 7 and 32, wherein the rankings are presented in a Harvey-ball format. The Harvey-ball format is an old and well known display format that uses moon phases to indicate association levels of an item based on certain criteria. The Harvey-ball format provides a quick and easy way for a user to view compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display rankings of items using a Harvey-ball format because such a display would provide users with a quick and easy means for assessing the rankings.

As per claims 9 and 15, Wright et al. does not expressly disclose the method of claim 1, wherein the rankings are displayed in a graphical user interface in a numerical format. However, numerical formats for displaying rankings are old and well known in the art. Numerical formats also provide a quick and easy way for a user to view compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to display rankings using a numerical format because such a display would provide users with a quick and easy means for assessing the rankings.

As per claims 22 and 34, Wright et al. does not expressly disclose the method and computer system of claims 18 and 32, further comprising the step of entering information concerning strength of a business relationship by entering a number from 1 to 5, and wherein the step of calculating the advantage of the structures is based on the entered information concerning the strength of a business relationship. However, Wright et al. does disclose that information such as capabilities, *ratings* and preferences are used to evaluate resource providers for projects and to assess which resource providers would compliment each other on a project (col. 9, lines 19-45). Using numbers to rate an item is old and well known in the art. Additionally, assessing whether vendors would compliment each other on a project is a form of measuring the strength of a business relationship. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Wright et al. to use numbers from 1 to 5 to indicate the strength of a business relationship because using numbers to rate an item is an old and well known process and further, provides a quantitative assessment of resource providers that is easy for project managers to comprehend and use in their evaluation of the resource providers.

As per claim 23, Wright et al. discloses the method of claim 22, wherein the information is entered through at least one template stored in a computer (col. 5, lines 45-67; col. 6, lines 17-30).

As per claim 24, Wright et al. discloses the method of claim 23, wherein the information entered through at least one template calls up at least one template of

predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 5, lines 45-67; col. 6, lines 17-30; col. 7, line 66-col. 8, line 59).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Quackenbush et al. (US 2003/0172014) discusses a system and method for online valuation; and
- Chandler et al. (US 2002/0032599) discusses a system and method for venture acceleration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

703-872-9306

[Official Communications; including After Final  
communications labeled "Box AF"]

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703-746-7202


[For status inquiries, draft communication, labeled

"Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA 7<sup>th</sup> floor receptionist.

  
emc

October 29, 2004

  
**SUSANNA M. DIAZ**  
**PRIMARY EXAMINER**  
A.U. 3623